IN THE SPECIFICATION:

Please amend the specification as follows:

Please delete Figures 20-64, which were added in the Preliminary Amendment submitted on January 30, 1997.

N.E. E

REMARKS

Informalities

At pages 2 and 3 of the Office Action, the Examiner addressed informalities concerning the drawing figures and declaration. As permitted under 37 C.F.R. § 1.111(b), applicants request that these informal matters be held in abeyance until the application is otherwise indicated to be allowable.

The Examiner also indicated that the references that were submitted with the Information Disclosure Statement filed December 14, 1999, were not included in the submission as she received it. Applicants enclose a receipt marked postcard that shows that the U.S. Patent and Trademark Office received copies of 133 references and two papers from opposition of EPO Patent No. 0 341 273 B1. Applicants also believe that copies of those documents were submitted or cited by the Examiner in copending U.S. Patent Application Serial No. 08/304,437 or a parent of that application. If the Examiner still needs copies of those documents, applicants request that the Examiner call the undersigned so that he can resubmit any needed copies.

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Alleged New Matter

The Examiner objected to the amendment filed November 26, 1997 (Paper No. 10)[1], under 35 U.S.C. § 132, because it allegedly introduced new matter into the disclosure. See Action at pages 3 to 4. The Examiner indicated that Figures 20 to 64 were new matter not supported by the original disclosure. The Examiner contended that those figures could not be added since the parent application U.S. Serial No. 07/555,274 was not properly incorporated by reference. *Id.* Applicants assert that the parent application U.S. Serial No. 07/555,274 was properly incorporated by reference. See the originally filed specification at page 24, last paragraph.

The Examiner also indicates that a proper incorporation by reference has to specifically refer to what matter was being incorporated. The incorporation by reference included the entire referenced application. However, since the claims are presently not directed to the subject matter discussed in Figures 20 to 64, applicants have deleted those figures. This deletion is solely to expedite prosecution and is not an acquiescence to the rejection.

The Examiner also objected to the amendment filed on May 7, 1999, under 35 U.S.C. § 132, because it allegedly introduced new matter into the disclosure. See Action at page 4. The Examiner contended that the material inserted at page 25, line

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[1] The amendment that introduced Figures 20 to 64 was filed on January 30, 1997.

12, is not supported by the initial disclosure, since the incorporation by reference to U.S. Patent No. 5,075,222 allegedly is not proper. *Id.*

Applicants respectfully traverse this objection. U.S. Patent No. 5,075,222 is properly incorporated by reference at page 24, last paragraph, of the specification. The application from which that patent issued (U.S. Serial No. 07/506,522) is also incorporated by reference at page 10, first full paragraph. Applicants respectfully assert that by incorporating by reference U.S. Patent No. 5,075,222 and the application from which it issued, the present application is considered to include within its initial disclosure ***all of the subject matter*** of the patent and application.

In fact, in a clarification of the law of incorporation by reference, the U.S. Patent and Trademark Office stated that

> an applicant may incorporate by reference the prior application by including, in the continuing application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated by reference herein by reference." The inclusion of this incorporation by reference of the prior application(s) ***will permit an applicant to amend the continuing application to include any subject matter in such prior application(s)*** without the need for a petition.

See Federal Register, Vol. 62, No. 197, October 10, 1997 at page 53146, emphasis added. (A copy of this citation is enclosed.)

Case law is consistent with the quoted material above. Specifically, the Court stated that "the purpose of 'incorporation by reference' is to make one document become a part of another document by referring to the form[er] in the latter in such a

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manner that it is apparent that ***the cited document is part of the referencing document as if it were fully set out therein***." *In re Lund*, 153 U.S.P.Q. 625, 631 (C.C.P.A. 1967) (emphasis added).[2]

Thus, the present application should be considered to include all of the disclosure of U.S. Patent No. 5,075,222 (and the application from which it issued) and the application can be amended to include any disclosure from that patent. Accordingly, no new matter has been introduced into the specification.

Double Patenting Rejections

The Examiner rejected claims 22 to 25 and 37 to 40 over U.S. Patent No. 5,075,222 (the '222 patent) under the judicially created doctrine of obviousness-type double patenting. Action at page 5. If the Examiner holds that the presently pending claims are otherwise allowable, applicants will file a terminal disclaimer in view of the '222 patent. Thus, this rejection will be obviated. Applicants are not filing such a disclaimer at this time, since the claims may change prior to an indication of allowance, and the claims pending after such changes may not be subject to a double patenting rejection.

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2 Unlike the present situation, in *Lund*, the application in question failed to explicitly incorporate by reference the earlier document. Thus, the earlier document was held not to be properly incorporated by reference.

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The Examiner rejected claims 24 and 25 over U.S. Patent No. 5,453,490 (the '490 patent) under the judicially created doctrine of obviousness-type double patenting. Action at page 5. If the Examiner holds that the presently pending claims are otherwise allowable, applicants will file a terminal disclaimer in view of the '490 patent. Thus, this rejection will be obviated. Applicants are not filing such a disclaimer at this time, since the claims may change prior to an indication of allowance, and the claims pending after such changes may not be subject to a double patenting rejection.

Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 22 to 23 and 37 to 39 under 35 U.S.C. § 112, first paragraphs, as allegedly "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Action at page 6. Specifically, the Examiner contends that the specification as originally filed has no basis for the homology limitations. *Id.*

For the reasons discussed above in response to the new matter objection, applicants respectfully assert that the initially filed specification supports the homology limitations in view of the proper incorporation by reference of U.S. Patent No. 5,075,222 and the application from which it issued. The support for the inserted material

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concerning homology in U.S. Patent No. 5,075,222 is discussed in the Amendment dated April 23, 1999 at page 4. Accordingly, applicants respectfully traverse the rejection under § 112, first paragraph, and request reconsideration and withdrawal of it.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

By: _____
M. Paul Barker
Reg. No. 32,013

Dated: August 3, 2000

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